

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Anthony A. Shah-Nazaroff, et al.

Application No.: 09/580,305

Filed: May 26, 2000

For: METHOD AND APPARATUS FOR
ORDERING ENTERTAINMENT
PROGRAMS FROM DIFFERENT
PROGRAMMING TRANSMISSION
SOURCES

Examiner: Jason P. Salce

Art Group: 2421

Confirmation No.: 9133

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APPELLANT'S APPEAL BRIEF

TO THE HONORABLE COMMISSIONER FOR PATENTS:

This is Appellant's Brief submitted in support of the Notice of Appeal to the Board of Patent Appeals and Interferences filed on April 21, 2009, appealing the decision of the Examiner in the Final Office Action mailed January 22, 2009, in which claims 1-6, 8-16, 18-20, and 25-26 of the subject patent application were again rejected. Appellant respectfully requests consideration of this Appeal by the Board of Patent Appeals and Interferences for allowance of the subject patent application.

I. REAL PARTY IN INTEREST

The real party in interest in the subject patent application is Intel Corporation of Santa Clara, CA.

II. RELATED APPEALS AND INTERFERENCES

The Appellant's undersigned attorney and the assignee identified above are not aware of other appeals or interferences that would directly affect or be directly affected by, or have a bearing on the Board's decision in the subject Appeal.

III. STATUS OF THE CLAIMS

Claims 1-6, 8-16, 18-20, and 25-26 are pending. Claims 7, 17, and 21-24 were previously canceled. Claims 1-6, 8-16, 18-20, and 25-26 were rejected and are presently appealed.

Claims 1-6, 8-16, 18-20, and 25-26 were rejected under 35 U.S.C. §103(a) over Majeti et al. (USP 5,512,935) ("Majeti") in view of Rothblatt (USP 6,105,060) ("Rothblatt").

IV. STATUS OF AMENDMENTS

No amendments have been presented after the Final Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

Independent claim 1 is directed towards a method comprising: receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media (p.2 ll.10-11; p.4 ll.3-5; p.7 ll.18-19; p.8 ll.1-11; p.9 ll.21-22; and p.13 ll.8-9; see also FIG. 1-4); automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media being different than the second communication media (p.4 ll.4-5; p.7 ll.19-21; and p.8 ll.12-18; see also FIG. 1-4); and automatically coordinating provision of the upgraded media feature for the programming transmission, the programming transmission and the upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media being different than the first and second communication media (pp.7 ll.20-21; p.8 ll.1-11; and p.10 ll.1-4; see also FIG 1-4). In particular, please refer to the disclosure on page 6 line 7 to page 7 line 16 for embodiments of the upgraded media features.

Independent claim 8 is directed towards a method of sending, by a client system, a selection to buy an upgraded media feature for a programming transmission to a server system via a first communication media to enable the server system to coordinate provision of the upgraded media feature with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media (p.2 ll.10-11; p.4 ll.3-5; p.7 ll.18-19; p.8 ll.1-11; p.9 ll.21-22; and p.13 ll.8-9; see also FIG. 1-4)); and receiving the programming transmission with the upgraded media feature from the one programming transmission source via a third communication media, the third communication media different than the first and second communication media (p.8 ll.1-11; p.13 ll.11-13; and p.16 ll.20-24; see also FIG. 1-4, and 6).

Independent claims 14 and 18, are equivalent to independent claims 1 and 8, respectively, with the exception that they are written in computer program product form. Therefore, support can be found in the specification and the drawings as set forth above for claims 1 and 8. In addition, with reference to Figure 7, mass storage 720 is used to provide permanent storage for the data and programming instructions to implement the features of claims 14 and 18 (p.19 ll.3-4).

Independent claim 25 is directed towards an apparatus comprising a receiver to receive, via a first communication media, a selection to buy an upgraded media feature for a programming transmission (Fig. 3 Element 310), a purchasing unit to automatically coordinate purchase of the upgraded media feature for the programming transmission from one of a plurality of programming transmission sources via a second communications media, the first communication media different than the second communication media (Fig.3 Element 330), and a provision unit to automatically coordinate provision of the upgraded media feature for the programming transmission (Fig.3 Element 330 with the one programming transmission source, the programming transmission and upgraded media feature to be provided via a third communication media, the third communication media different than the first and second communication media. Support for the above recitations may also be found in Figure 1.

Independent claim 26 is directed towards an apparatus comprising a sending unit to send a selection to buy an upgraded media feature for programming transmission to a server system

via a first communications media to enable the server system to coordinate provision of the upgraded media feature with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media (Fig. 2 Element 210), and a receiving unit to receive the programming transmission from the one programming transmission source via a third communication media, the third communication media different than the first and second communication media (Fig. 2 Element 230). In depth support for the above recitations is also provided, with reference to Fig. 6, from page16 line 20 to page 18 line 6.

In summary, the claimed subject matter provides an improved method and apparatus for selecting/receiving upgraded media features for programming transmissions. Information regarding a plurality of entertainment programs and upgraded media features are received by a client system. A server system receives, from the client system, a selection of an upgraded media feature for a particular programming transmission and automatically coordinates purchase and provision of the upgraded media feature and programming transmission from one of many programming transmission sources. The entertainment program selection together with one or more upgraded media feature selections are transmitted to the client system (See Fig. 4, block 460).

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-6, 8-16, 18-20, and 25-26 are unpatentable under 35 U.S.C. §103(a) in light of Majeti and Rothblatt.

VII. ARGUMENT

REJECTIONS UNDER 35 U.S.C. §103

As is well established, the Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. See MPEP 2142. “Section 103 forbids issuance of a patent when the ‘differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.’” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1734 (2007). KSR reaffirms the framework set out in

Graham v. John Deere Co. of Kansas City, 383 U.S. 1 (1966), which mandates that an objective obvious analysis includes: (1) determining the scope and content of the prior art; (2) ascertaining the differences between the prior art and the claims at issue; and (3) resolving the level of ordinary skill in the pertinent art. *KSR*, 127 S.Ct. at 1734.

Insufficient Factual Basis to Support Findings of Obviousness

The Examiner has failed to provide a sufficient factual basis to support a *prima facie* case of obviousness of claims 1-6, 8-16, 18-20, and 25-26 over the cited references. In particular, ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole. See MPEP 2141.02. This has not been done, as further detailed below.

Claim 1 recites a method comprising:

receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media;

automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media different than the first and second communication media.

Neither Majeti nor Rothblatt teach or suggest at least the recitations of “receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client ...”; “automatically coordinating purchase ... of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media ...”; and “automatically coordinating provision ... of the upgraded media feature for the programming transmission, the programming transmission and the upgraded media feature to be provided from the one programming transmission source to the client system”

Majeti, in contrast to the claims, is directed toward “provid[ing] an improved method and corresponding apparatus for alerting the user of a personal computer that predetermined parameters set by the user have been reached, as determined by a service provider.” *Majeti*, c.2 ll.38-43. For example, Majeti teaches that an alert may be sent by a service provider to a user’s computer system, and subsequently, to a user’s television in tandem with television programming. *Majeti*, c.2 ll. 53-56. This increases the probability that the alert, which is wholly unrelated to the television programming, will be received. In other embodiments, Majeti teaches that a user may request information from a service provider. Based upon a variety of factors, such as the amount of information requested, the information may be transmitted over the public switched telephone network (“PSTN”), or alternatively, a high bandwidth cable television network. One of ordinary skill in the art, when reading Majeti, would understand that its teachings are directed toward providing two independent sources of information to a user in an efficient manner, which may include transmitting the two sources over a cable network.

Majeti fails to teach or fairly suggest “receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission.” Interpreting this element in light of the specification, as is required by *Phillips v. AWH Corp.*, requires that the upgraded media feature be an upgrade for the programming transmission. 415 F.3d 1303, 1315. Majeti merely teaches the transmission of information. The information is described as travel information, stock quotes, pictures, etc. This information, even when given its broadest reasonable interpretation, could not be construed to be an “upgraded media feature for a programming transmission.” Furthermore, the claim recites that the server system receives “a selection,” which clearly indicates that an upgraded media feature was selected from one or more alternative upgrades. As stated previously, Majeti merely teaches the requesting of random information from a service provider, with no express teachings that the information is an upgraded media feature for a programming transmission.

Furthermore, even if we were to assume that the information requested in Majeti could be construed as an upgraded media feature, which Appellant disputes, the information is still not “for the programming transmission” as clearly recited in the claims. When viewing this recitation in light of the remaining claim recitations (viewing the claim as a whole) and the specification, as required by law, it is clear that the upgraded media feature directly

supplements, that is, is for the programming transmission. To construe the recitation otherwise would render the term “upgraded” superfluous. Additionally, Appellant respectfully notes that there is no suggestion, within Majeti, that the information solicited from the “enhanced service provider” is for the programming transmission because Majeti explicitly teaches that the information is split off from the cable programming and provided to a separate user device. This teaching is directly contrary to the recitation that the upgraded media feature is for the programming transmission. The claim, therefore, remains allowable over Majeti for at least this additional reason.

Majeti fails to teach or fairly suggest “automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources” The equated server system of Majeti merely routes the request to the already identified service provider. “The request is routed by the split channel bridging unit to the corresponding enhanced service provider to which the request was directed.” *Majeti*, c.3 ll.41-44 (emphasis ours). One difference between claim 1 and Majeti is that the server system of claim 1 receives a selection, and the server system of Majeti receives a requested directed toward a predetermined “service provider.” There is no suggestion within Majeti of “automatically coordinating purchase with one of a plurality of programming transmission sources” because the server system merely routes requests, and is not capable of coordinating purchase as recited in the claim. Consequently, Majeti cannot be said to either teach or suggest this recitation. Therefore, claim 1 is allowable over Majeti for at least this additional reason.

Majeti also fails to teach or fairly suggest “automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media different than the first and second communication media” (emphasis ours).

In Majeti, the sources of the information (i.e., upgraded media feature) and television programming (i.e., programming transmission) are clearly provided by separate entities. The

information is provided by the “enhanced service provider” and the television programming is provided by a “cable company.” The combination of information from both of these independent sources is the focus of Majeti’s teachings, that is the inclusion of the information over the high bandwidth network of the cable company. The Examiner acknowledges this construct through his rejection. He notes in his rejection that he “has interpreted the claim as only the ‘upgraded media feature’ being provided from the one programing transmission source” *Final Office Action*, p.4. This is directly contrary to the claim which expressly states that the programming transmisison and the upgraded media feature are provided from the one programming transmisison source. For at least this additional reason claim 1 is allowable over Majeti.

Rothblatt, relied on in combination with Majeti, similarly fails to teach these recitaitons. Rothblatt is merley relied upon by the Examiner to teach or suggest the purchasing aspects of the instant claim. Consequently, even when Majeti is viewed in combination with Rothblatt the two fail to teach or suggest the recitations of the instant claim.

For at least these reasons, Appellant respectfully asserts there is insufficient factual basis to support an obviousness rejection of claim 1 over these references.

Claims 2-6, 8-16, 18-20, and 25-26 either depend from, or include recitations similar to, claim 1. Accordingly, these claims are patentable over these references for at least similar reasons.

VIII. CONCLUSION

Appellant respectfully submits that all the appealed claims in this application are patentable and requests that the Board of Patent Appeals and Interferences overrule the Examiner and direct allowance of the rejected claims.

This brief is submitted with a check for \$540 or an authorization to charge a deposit account to cover the appeal fee for one other than a small entity as specified in 37 C.F.R. § 1.17(c). We do not believe any other fees are needed. However, should that be necessary, please charge Deposit Account No. 500393. In addition, please credit any overages to the same account.

SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: June 16, 2009

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CLAIMS APPENDIX

1. (Previously presented) A method comprising:
 - receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media;
 - automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and
 - automatically coordinating provision, by the server system, of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided from the one programming transmission source to the client system via a third communication media, the third communication media different than the first and second communication media.
2. (Previously presented) The method of claim 1 wherein the receiving comprises receiving the selection from an entertainment system, and the programming transmission is provided to the entertainment system with the upgraded media feature via the third communication media.
3. (Previously presented) The method of claim 1 wherein the automatically coordinating the purchase of the upgraded media feature comprises:
 - billing, by the server system, the client system for services performed by the server system; and
 - providing billing information associated with the client system to at least the one programming transmission source that provided the programming transmission.
4. (Original) The method of claim 3 wherein the billing is one of performed individually for each billable transaction and performed according to a billing cycle for at least one billable transaction during the billing cycle.
5. (Previously presented) The method of claim 1 wherein the automatically coordinating the

purchase of the upgraded media feature comprises:

billing, by the server system, the client system for services performed by the server system and at least the one programming transmission source that provided the programming transmission; and

receiving a bill for the portion of the services performed by at least the one programming transmission source at a later time.

6. (Original) The method of claim 5 wherein the billing the client and receiving the bill are one of performed individually for each billable transaction and performed according to a billing cycle for at least one transaction during the billing cycle.

7. (Canceled)

8. (Previously presented) A method comprising:

sending, by a client system, a selection to buy an upgraded media feature for a programming transmission to a server system via a first communication media to enable the server system to coordinate provision of the upgraded media feature with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

receiving the programming transmission with the upgraded media feature from the one programming transmission source via a third communication media, the third communication media different than the first and second communication media.

9. (Original) The method of claim 8 further comprising:

receiving a bill, said bill based at least in part on receiving the upgraded media feature.

10. (Original) The method of claim 9 wherein the receiving the bill comprises a charge to a credit account at one of the end of a billing cycle and at a time when the upgraded media feature is received.

11. (Original) The method of claim 8 wherein the programming transmission comprises at least

one of a movie, a documentary, an audio production, an interactive media event, a situation comedy, a news program, and a televised sports event.

12. (Original) The method of claim 8 wherein the upgraded media feature comprises at least one of a video upgrade, an audio upgrade, a recordable version, and an increased access rate for an interactive event.

13. (Previously presented) The method of claim 8 wherein the plurality of programming transmission sources include a least one of cable television, antenna reception, satellite reception, mini-dish satellite reception, telephone dial-up service, or Internet access.

14. (Previously presented) A machine readable storage medium having stored thereon machine readable instructions, execution of said machine readable instructions to implement a method comprising:

receiving, by a server system, a selection to buy an upgraded media feature for a programming transmission from a client system via a first communication media;

automatically coordinating purchase, by the server system, of the upgraded media feature for the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

automatically coordinating provision of the upgraded media feature for the programming transmission, the programming transmission and upgraded media feature to be provided to the client system via a third communication media, the third communication media different than the first and second communication media.

15. (Previously presented) The machine readable storage medium of claim 14, execution of said machine readable instructions to further implement:

billing, by the server system, the client system for services performed by the server system; and

providing billing information about the client system to at least the one programming transmission source that provided the programming transmission.

16. (Previously presented) The machine readable storage medium of claim 14 execution of said machine readable instructions to further implement:

billing, by the server system, the client system for services performed by a server system and at least the one programming transmission source that provided the programming transmission; and

receiving a bill for the portion of the services performed by at least the one programming transmission source at a later time.

17. (Canceled)

18. (Previously presented) A machine readable storage medium having stored thereon machine readable instructions, execution of said machine readable instructions to implement a method comprising:

sending, by a client system, a selection to buy an upgraded media feature for a programming transmission to a server system via a first communication media to enable the server system to coordinate provision of the upgraded media feature and the programming transmission with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

receiving the programming transmission with the upgraded media feature from the one programming transmission source via a third communication media, the third communication media different than the first and second communication media.

19. (Previously presented) The machine readable storage medium of claim 18 execution of said machine readable instructions to further implement:

receiving a bill, said bill based at least in part on receiving the upgraded media feature.

20. (Original) The machine readable storage medium of claim 19 wherein the receiving the bill comprises a charge to a credit account at one of the end of a billing cycle and at a time when the upgraded media feature is received.

21. – 24. (Canceled)

25. (Previously presented) An apparatus comprising:

- a receiver to receive, via a first communication media, a selection to buy an upgraded media feature for a programming transmission;

- a purchasing unit to automatically coordinate purchase of the upgraded media feature for the programming transmission from one of a plurality of programming transmission sources via a second communications media, the first communication media different than the second communication media; and

- a provision unit to automatically coordinate provision of the upgraded media feature for the programming transmission with the one programming transmission source, the programming transmission and upgraded media feature to be provided via a third communication media, the third communication media different than the first and second communication media.

26. (Previously presented) An apparatus comprising:

- a sending unit to send a selection to buy an upgraded media feature for a programming transmission to a server system via a first communications media to enable the server system to coordinate provision of the upgraded media feature with one of a plurality of programming transmission sources via a second communication media, the first communication media different than the second communication media; and

- a receiving unit to receive the programming transmission from the one programming transmission source via a third communication media, the third communication media different than the first and second communication media.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.